

08/22/01



jc950 U.S. PTO

PATENT

08/24/01

ATTORNEY DOCKET NO. TUIN.002.05US

jc972 U.S. PTO

09/935367



08/22/01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Wigler *et al.*

) Examiner: Not assigned

Serial No.: Not Assigned

) Art Unit: Not assigned

Filed:

)

For: **A REPRESENTATIONAL APPROACH
TO DNA ANALYSIS**) **PRELIMINARY AMENDMENT****BOX PATENT APPLICATION**Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants respectfully request entry of this preliminary amendment. A (i) Version with Markings to Show Changes Made to the specification and claims; and (ii) Clean Copy of Claims; are attached hereto as separate sheets.

REMARKS**Amendments**

The amendments attached with this document are to correct omissions and stylistic and typographical errors.

In the Specification

A substitute page 1 of the specification for the above-referenced patent application is submitted with the attached "Version with Markings to Show Changes Made".

CERTIFICATE OF EXPRESS MAILING"Express Mail" Label No EL737340085USDate of Deposit: Aug 22, 2001

I hereby certify under 37 C F R 1.10 that this correspondence is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" with sufficient postage on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington, D C 20231

(Signature)

(Printed Name)

Jeffrey M Libby

In the Claims

Claims 1-18 have been cancelled.


New claims 19-30 have been added. Claims 19-25 are directed to a DNA probe. Support for new Claims 19-25 is found in originally filed Claims 1, 9, 13 and 14, and on pages 5-9. Claim 26 is directed to a kit. Support for new Claim 26 is found in originally filed Claims 15-18. Claim 27 is directed to a method of identifying sites that differ between two different eukaryotic DNA sources. Support for new Claim 27 is found on page 10, lines 3-12. Claim 28 is directed to a composition comprising a pooled plurality of DNA probes. Support for new Claim 28 is found on page 10, lines 13-24. Claims 29 and 30 are directed to a method for detecting at least one genomic alteration occurring in a cancer cell as compared to a normal cell. Support for new Claims 29 and 30 are found on page 12, lines 17-28. Claim 31 is directed to a method of identifying a pathogen DNA sequence incorporated into the genome of a eukaryotic cell. Support is found in the claims as originally filed. Support of new Claim 31 is found on page 11, line 19 through page 12, line 6.

CONCLUSION

Should the Examiner have any questions regarding the above, the Examiner is invited to call the Undersigned.

Respectfully submitted,

Dated: August 22, 2001


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BRV/JML/jml

PATENT

ATTORNEY DOCKET NO. TUIN.002.05US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Wigler and Lisitsyn) Examiner: Not Yet Assigned
Serial No.: Not Yet Assigned) Art Unit: Not Yet Assigned
Filed:) UTILITY PATENT APPLICATION
For: **A REPRESENTATIONAL APPROACH**) TRANSMITTAL
TO DNA ANALYSIS)

BOX PATENT APPLICATION

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

This is a request for filing a patent application under 37 CFR § 1.53(b) in the name of inventors: Michael Wigler and Nikolai Lisitsyn.

For: **A REPRESENTATIONAL APPROACH TO DNA ANALYSIS**

Attorney Docket No.: TUIN.002.05US

This application is a continuation of application Ser. No. 09/261,079 filed March 2, 1999, which is a continuation of application Ser. No. 09/115,061 filed July 14, 1998, now U.S. Pat. No. 6,159,713, which is a continuation of application Ser. No. 08/478,242 filed June 7, 1995, now U.S. Pat. No. 5,876,929, which is a continuation of application Ser. No. 08/149,199 filed November 9, 1993, now U.S. Pat. No. 5,501,964, which is a continuation-in-part of application Ser. No. 07/974,447 filed November 12, 1992, now U.S. Pat. No. 5,436,142.

CERTIFICATE OF EXPRESS MAILING

"Express Mail" Label No.: EL737340085US

Date of Deposit: Aug 22, 2001

I hereby certify under 37 C.F.R. 1.10 that this correspondence is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" with sufficient postage on the date indicated above and is addressed to BOX PATENT APPLICATION, Assistant Commissioner for Patents, Washington, D C , 20231.

(Signature)

(Printed Name)

Jeffrey M. 2.66

Applicants note that they did not receive an issue notification for the parent application, 09/261,079, which has now issued as U.S. Patent No. 6,277,606, on August 21, 2001. This application is being filed on one day after the parent application issued as a patent. A Petition to the Commissioner to claim benefit of filing date of the parent application will be filed.

Application Elements:

42 Pages of Specification, Claims and Abstract

4 Sheets of Formal Drawings

☒ Declaration

☐ Newly executed (original or copy)

☒ Copy from prior application (37 CFR 1.63(d) for a continuation or divisional).

The entire disclosure of the prior application from which a copy of the declaration is herein supplied is considered as being part of the disclosure of the accompanying application and is hereby incorporated by reference therein.

☐ Deletion of inventors Signed statement attached deleting inventor(s) named in the prior application, *see* CFR 1.63(d)(2) and 1.33(b).

Accompanying Application Parts:

☐ Assignment and Assignment Recordation Cover Sheet (recording fee of \$40.00 enclosed)

☐ Power of Attorney.

☒ Associate Power of Attorney.

☐ 37 CFR 3.73(b) Statement by Assignee

☐ Information Disclosure Statement with Form 1449

☐ Copies of IDS Citations

☒ Preliminary Amendment

☒ Clean Copy of Claims

☒ Version with Markings to Show Changes Made

☒ Return Receipt Postcard

☒ Small Entity Statement(s) ☒ Statement filed in prior application.
Status still proper and desired.

☒ Other:
copy of Revocation and Appointment of New Power of Attorney from prior application.

Claim For Foreign Priority

☐ Priority of _____ Application No. _____ filed on _____
is claimed under 35 U.S.C. § 119

☐ The certified copy has been filed in prior application U.S. Application No. _____

☐ the certified copy will follow.

Extension of Time for Prior Pending Application

☐ A Petition for Extension of Time is being concurrently filed in the prior pending application. A copy of the Petition for Extension of Time is attached.

Amendments

- ☒ See Preliminary Amendment
- ☐ Amend the specification by inserting before the first line the sentence: "This is a ☒ Continuation ☐ Continuation-in-part ☐ Nonprovisional application of copending prior
- ☐ Application Serial No. _____ filed on _____.
- ☐ International Application _____ filed on _____, which designated the United States, disclosure of which is incorporated herein by reference."
- ☒ Cancel in this application original Claims 1-18 of the prior application before calculating the filing fee

Fee Calculation (37 CFR § 1.16):

	(Col. 1)	(Col. 2)	<u>SMALL</u> <u>ENTITY</u>		OTHER THAN A <u>SMALL ENTITY</u>	
<u>FOR:</u>	<u>NO. FILED</u>	<u>NO.</u> <u>EXTRA</u>	<u>RATE</u>	<u>FEE</u>	<u>RATE</u>	<u>FEE</u>
Basic Fee			\$355	\$355	\$710	\$0.00
Total Claims	13	0	\$ 9	\$0	\$ 18	\$0.00
Indep. Claims	6	2	\$ 40	\$80	\$ 80	\$0.00
<input type="checkbox"/> Multiple Dep. Claims			\$135	\$0	\$270	
Total Filing Fee:						\$435.00

TOTAL FEES: \$435.00

☒ A check including the amount of the above-indicated TOTAL FEES is attached.

[] Please charge Deposit Account No.18-0020 in the amount of \$_____.

[] No fee is required.

[X] Conditional Petition for Extension of Time: An extension of time is requested in the present and/or the above-referenced parent application to provide for timely filing if an extension of time is still required after all papers filed with this transmittal have been considered.

[X] The Commissioner is hereby authorized to charge any underpayment of the following fees associated with this communication, including any necessary fees for extension of time, or credit any overpayment to Deposit Account No. 18-0020.

[X] Any filing fees under 37 CFR 1.16 including fees for the presentation of extra claims.

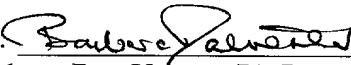
[X] Any parent application processing fees under 37 CFR 1.17.

[X] A **duplicate** copy of this sheet is attached for accounting purposes.

[X] *This application is being filed fee deferred.*

Respectfully submitted,

Dated: August 22, 2001

By: 
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